

## **REMARKS**

### **I. Introduction**

With the cancellation herein without prejudice of claim 9, claims 10 to 19 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

As an initial matter, Applicants note that the Office Action Summary does not include an acknowledgment of the claim of foreign priority and does not include an acknowledgment of receipt of a certified copy of the priority document. A claim of priority to Application No. 100 15 299.6, filed in the Federal Republic of Germany on March 28, 2000, was made, inter alia, in the "Declaration and Power of Attorney," filed on March 28, 2002, and a certified copy of German Application No. 100 15 299.6 was filed on January 20, 2004.

Applicants thank the Examiner for returning an initialed copy of the PTO-1449 paper submitted with the Supplemental Information Disclosure Statement filed on January 20, 2004.

### **II. Finality of the Office Action**

As an initial matter, Applicants respectfully submit that the finality of the present Office Action is improper and respectfully request withdrawal of the present Office Action. In this regard, the present Office Action states at page 4 that "Applicant[s]' submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 1/22/04 prompted the new ground(s) of rejection presented in this Office Action." However, the one reference listed in the PTO-1449 paper attached to the Supplemental Information Disclosure Statement, namely European Published Patent Application No. 1 078 803, was listed in the PTO-1449 paper attached to the Information Disclosure Statement filed on November 28, 2001, and was listed in the International Search Report dated June 15, 2001 in the underlying PCT application, PCT/DE01/00552. Both the "Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" dated January 28, 2002 and the "Notice of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495" dated March 14, 2003 indicate that the United States Patent and Trademark Office received a copy of the International Search Report and copies of references cited in

the International Search Report. As stated in M.P.E.P. § 1893.03(g), “[t]he examiner will consider the documents cited in the international search report, without any further action by applicant under 37 CFR 1.97 and 1.98, when both the international search report and copies of the documents are indicated to be present in the national stage file.” As further stated in M.P.E.P. § 609, “[t]he examiner will consider the documents cited in the international search report in a PCT national stage application when the Form PCT/DO/EO/903 [i.e., the “Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495,”] indicates that both the international search report and the copies of the documents are present in the national stage file.” As indicated above, the “Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495” indicates that the United States Patent and Trademark Office received a copy of the International Search Report, which listed European Published Patent Application No. 1 078 803, and indicates that the United States Patent and Trademark Office received copies of the references cited in the International Search Report. Accordingly, it is respectfully submitted that European Published Patent Application No. 1 078 803 was of record in the present application by virtue of being cited in the International Search Report and the “Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495” indicating receipt by the United States Patent and Trademark Office of the International Search Report and the references cited in the International Search Report. It is therefore respectfully submitted that the finality of the present Office Action is improper, and withdrawal of the finality of the present Office Action is respectfully requested.

### **III. Allowable Subject Matter**

Applicants note with appreciation the indication of allowable subject matter contained in claims 13 to 16. In this regard, the Examiner will note that each of claims 13 and 15 has been rewritten herein in independent form to include all of the limitations of its respective base claim and any intervening claims. It is therefore respectfully submitted that claims 13 and 15 are in condition for immediate allowance.

Since claim 14 depends from claim 13, it is respectfully submitted that claim 14 is in condition for immediate allowance.

Since claim 16 depends from claim 15, it is respectfully submitted that claim 16 is in condition for immediate allowance.

Claims 10, 11, 17 and 18 have been amended herein without prejudice to depend from claim 13, and claim 12 now ultimately depends from claim 13. It is therefore respectfully submitted that claims 10 to 12, 17 and 18 are in condition for immediate allowance.

**IV. Rejection of Claims 9, 11, 12 and 17 to 19 Under 35 U.S.C. § 102(b)**

Claims 9, 11, 12 and 17 to 19 were rejected under 35 U.S.C. § 102(b) as anticipated by European Published Patent Application No. 1 078 803. Applicants respectfully submit that European Published Patent Application No. 1 078 803 does not anticipate the present claims for the following reasons. European Published Patent Application No. 1 078 803 was published on **February 28, 2001**. The present application is a national stage application based on PCT International Application No. PCT/DE01/00552, having an international filing date of **February 14, 2001**. Since the **February 14, 2001** international filing date of the present application is **earlier** than the **February 28, 2001** publication date of European Published Patent Application No. 1 078 803, it is respectfully submitted that European Published Patent Application No. 1 078 803 does not constitute prior art against the present application.

Notwithstanding the foregoing, claim 9 has been canceled herein without prejudice, claims 11, 17 and 18 have been amended herein without prejudice to depend from claim 13, which was indicated to include allowable subject matter, claim 12 now ultimately depends from claim 13, and claim 19 has been amended herein without prejudice to include limitations analogous to limitations included in claim 13.

In view of all of the foregoing, it is respectfully submitted that the present rejection is moot, and withdrawal of this rejection is respectfully requested.

**V. Rejection of Claim 10 Under 35 U.S.C. § 103(a)**

Claim 10 was rejected under 35 U.S.C. § 103(a) as unpatentable over European Published Patent Application No. 1 078 803. Applicants respectfully submit that European Published Patent Application No. 1 078 803 does not render unpatentable the claim 10 for the following reasons.

As indicated above, European Published Patent Application No. 1 078 803 was published after the filing date of the present application. Therefore, European Published Patent Application No. 1 078 803 does not constitute prior art against the present application. Notwithstanding the foregoing, claim 10 has been amended herein without prejudice to depend from claim 13, which was indicated to include allowable subject matter. In view of the foregoing, it is respectfully submitted that the present rejection is moot, and withdrawal of the present rejection is respectfully requested.

#### VI. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

The Commissioner is hereby authorized to charge all fees that may be required in connection with this application, including any required extension of time fees under 37 C.F.R. §§ 1.17(a) or 1.136, to the deposit account of Kenyon & Kenyon, Deposit Account No. 11-0600. Furthermore, pursuant to 37 C.F.R. § 1.136(a)(3), the Commissioner is hereby authorized to treat this paper, as well as any concurrent or future reply in connection with this application, requiring a petition for an extension of time under 37 C.F.R. § 1.136 for its timely submission, as incorporating a petition for an extension of time for the appropriate length of time.

Respectfully submitted,

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